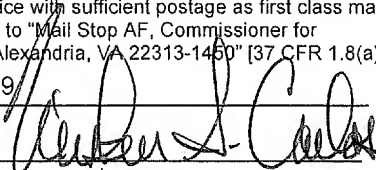
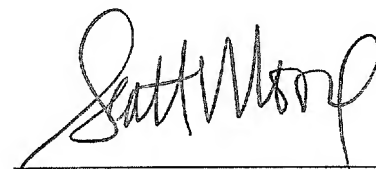


Doc Code: AP.PRE.REQ

PTO/SB/33 (07-09)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>December 3, 2009</u></p> <p>Signature <u></u></p> <p>Typed or printed name <u>Kirsten S. Carlos</u></p>		Application Number	Filed
		10/811,709	03/29/2004
		First Named Inventor	
		Timothy J. Thronson	
Art Unit		Examiner	
3687		Glass, Russell S	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>42,011</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>		<p><u></u> Signature</p> <p><u>D. Scott Moore</u> Typed or printed name</p> <p><u>919-854-1400</u> Telephone number</p> <p><u>December 3, 2009</u> Date</p>	
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**RESPONSE UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE--EXAMINING GROUP 1356**

Attorney Docket No. 9411-3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Timothy Thronson
Application No.: 10/811,709
Filed: March 29, 2004

Confirmation No.: 1356
Group Art Unit: 3687
Examiner: Glass, Russell S

For: **METHODS, SYSTEMS, AND COMPUTER PROGRAM PRODUCTS FOR
PROCESSING AND/OR PREPARING A TAX RETURN AND INITIATING
CERTAIN FINANCIAL TRANSACTIONS**

Date: December 3, 2009

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

REASONS IN SUPPORT OF APPLICANTS' PRE-APPEAL

BRIEF REQUEST FOR REVIEW

Sir:

This document is submitted in support of the Pre-Appeal Brief Request for Review filed concurrently with a Notice of Appeal in compliance with 37 C.F.R. 41.31 and with the rules set out in the OG of July 12, 2005 for the New Appeal Brief Conference Pilot Program, which have been extended indefinitely

No fee or extension of time is believed due for this request. However, if any fee or extension of time for this request is required, Applicants request that this be considered a petition therefor. The Commissioner is hereby authorized to charge any additional fee, which may be required, or credit any refund, to our Deposit Account No. 50-0220.

Applicants hereby request a Pre-Appeal Brief Review (hereinafter "Request") of the claims finally rejected in the Final Office Action mailed September 3, 2009 (hereinafter "Final Action"). The Request is provided herewith in accordance with the rules set out in the OG dated July 12, 2005.

Applicants respectfully submit that the rejection of the currently pending claims is clearly erroneous because many of the recitations of the pending independent claims are not met by the cited references for at least the reasons discussed herein and in Applicants' Amendment filed August 29, 2008. Therefore, Applicants respectfully request review of the

present application by an appeal conference prior to the filing of an appeal brief. In the interest of brevity and without waiving the right to argue additional grounds should this Petition be denied, Applicants will only discuss the recitations of independent Claims 1, 14, 28, 40, 51, 52, 53, 54, 55, 56, 57, 58, 59, 62, and 68.

Independent Claims 1, 51, and 55 are Patentable

Independent Claims 1, 51, and 55 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U. S. Patent No. 7,234,103 to Regan (hereinafter "Regan"). (Final Action, page 2). Independent Claim 1 is directed to a method of processing a tax return and recites, in part:

receiving tax information associated with a taxpayer, wherein the tax information is in a plurality of media formats;
... (Emphasis added).

Claims 51 and 55 include similar recitations. According to independent Claims 1, 51, and 55, the tax information is in multiple media formats. For example, the tax information may be recorded on paper and may also be stored electronically.

The Final Action cites col. 5, line 4 as describing the tax information as being in multiple formats. (Final Action, page 2). This line states "[m]ultiple documents and multiple document types are supported." This recitation from Regan does not state that the tax information is in multiple media formats just that multiple document types are supported. The types, for example, may refer to the various types of forms comprising a tax return. The Final Action further cites FIG. 29 of Regan as disclosing documents in PDF and HTML formats. (Final Action, page 2). The PDF and HTML formats are both electronic file formats and, therefore, are not multiple media formats as recited in independent Claims 1, 51, and 55.

For at least the foregoing reasons, Applicants respectfully submit that independent Claims 1, 51 and 55, as amended, are patentable over Regan, and that dependent Claims 2 – 13, 51, and 55 are patentable at least by virtue of their depending from an allowable claim.

Independent Claims 14, 40, 52, 54, 56, 58, 59, 62, and 68 are Patentable

Independent Claims 14, 40, 52, 54, 56, 58, 59, and 62 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Regan. (Final Action, page 2). Independent Claim 68 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Regan in view of U. S. Patent

No. 6,473,741 to Baker (hereinafter "Baker"). (Final Action, page 12). Independent Claim 14 is directed to a method of processing a tax return and recites, in part:

...
presenting the taxpayer with options for receiving value if the taxpayer
is entitled to a tax refund; and
...

Independent Claims 40, 52, 54, 56, 58, 59, 62, and 68 include similar recitations. The Final Action cites Regan's teachings regarding directing refunds to a tax payer account as disclosing the above-reproduced recitation. (Final Action, page 3). These recitations, however, state that multiple options are presented to the taxpayer for receiving value when the taxpayer is entitled to a tax refund. Regan states at col. 1, lines 25 – 36 that the IRS can pay tax refunds by electronic funds transfer. This passage of Regan does not appear to include any disclosure of presenting to a user multiple options for receiving value of the user is entitled to a tax refund. Moreover, Baker fails to provide the teachings missing from Regan.

For at least the foregoing reasons, Applicants respectfully submit that independent Claims 14, 40, 52, 54, 56, 58, 59, 62, and 68 are patentable over the cited references, and that dependent Claims 15 – 27, 41 – 44, 46 – 50, 60, 61, and 69 are patentable at least by virtue of their depending from an allowable claim.

Independent Claims 28, 53, and 57 is Patentable

Independent Claims 28, 53, and 57 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Regan. (Final Action, page 2). Independent Claim 28 is directed to a method of processing a tax return and recites, in part:

...
establishing an account with a financial institution if the taxpayer is
entitled to a refund.

Independent Claims 53 and 57 include similar recitations. The Final Action cites col. 1, lines 25 – 36 of Regan as disclosing the ability to establish an account with a financial institution if the taxpayer is entitled to a refund. (Final Action, page 3). This passage, however, merely states that the IRS has the ability to pay tax refunds by electronic transfer using the U. S. Treasury's automated clearing house (ACH) system. An ACH transaction starts with a

Receiver authorizing an Originator to issue ACH debit or credit to an account. A Receiver is the account holder that grants the authorization. Thus, the taxpayer must already have an account established with a financial institution for the refund to be paid by the ACH system. The ACH system does not establish an account with a financial institution if the taxpayer is entitled to a refund. This is illustrated, for example, in the taxpayer profile described at col. 27, lines 55 – 60 of Regan, in which the taxpayer already has an account identified by an account number established with a financial institution. Applicants can find no teaching or suggestion in Regan that the financial account is established if the taxpayer is entitled to a tax refund. Regan teaches that the financial account exists irrespective of whether the taxpayer is entitled to a refund or owes a tax as Regan shows the same account number is used to pay a tax owed as well as receive a refund payment.

For at least the foregoing reasons, Applicants respectfully submit that independent Claims 28, 53, and 57 are patentable over Regan, and that dependent Claims 29 - 39 are patentable at least by virtue of their depending from an allowable claim.

Independent Claim 63 is Patentable

Independent Claim 63 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Regan. (Final Action, page 2). Independent Claim 63 is directed to a method of initiating a financial transaction and recites, in part:

scanning at least one financial document;
...

The Final Action cites blocks 152 and 154 of FIG. 1A of Regan as disclosing scanning at least one financial document. (Final Action, page 3). Regan describes blocks 152 and 154 as follows:

First, in operation 152, tax-related forms are first retrieved in a database. Next, in operation 154, the retrieved tax-related forms are formatted, and the formatted tax-related forms are sent to a governmental entity.

Applicants submit that if the forms are retrieved from a database, then they are already in electronic form so any formatting performed at block 154 would not involve scanning. Furthermore, Applicants can find no teaching or suggestion in Regan that the computer 214 is

In re: Timothy Thronson
Application No.: 10/811,709
Filed: March 29, 2004
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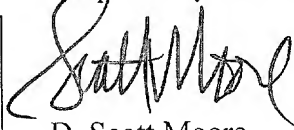
configured to scan financial documents to obtain information therefrom for use in initiating a financial transaction as recited in independent Claim 63.

For at least the foregoing reasons, Applicants respectfully submit that independent Claim 63 is patentable over Regan, and that dependent Claims 64 - 67 are patentable at least by virtue of their depending from an allowable claim.

Accordingly, for at least the foregoing reasons, Applicant respectfully requests that the present application be reviewed and that the rejection of independent Claims 1, 14, 28, 40, 51, 52, 53, 54, 55, 56, 57, 58, 59, 62, and 68 be reversed by the appeal conference prior to the filing of an appeal brief.

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Respectfully submitted,



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**CERTIFICATION OF
TRANSMISSION**

I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) to the U.S. Patent and Trademark Office on December 3, 2009.

Signature: _____



Kirsten S. Carlos